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04 JAN 2008

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In re Application of OTSUKI et al :
U.S. Application No.: 10/567,968 :
PCT Application No.: PCT/JP2004/011853 :
Int. Filing Date: 10 August 2004 :
Priority Date Claimed: 12 August 2003 : DECISION
Attorney Docket No.: 060131 :
For: ANTIVIRAL AGENT AND FIBERS AND :
ANTIVIRAL MEMBERS USING THE :
SAME :
:

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 28 December 2007.

BACKGROUND

On 10 August 2004, applicant filed international application PCT/JP2004/011853, which claimed priority of an earlier Japan application filed 12 August 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 17 February 2005. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2006.

On 17 February 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 30 August 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 November 2006, applicant filed a petition under 37 CFR 1.47(a).

On 26 February 2007, this Office mailed a decision dismissing the 28 November 2006 petition.

On 12 April 2007, applicant filed a renewed petition under 37 CFR 1.47(a).

On 24 April 2007, this Office mailed a decision dismissing the 12 April 2007 petition.

On 21 June 2007, applicant filed a second renewed petition under 37 CFR 1.47(a).

On 29 June 2007, this Office mailed a decision dismissing the 21 June 2007 petition.

On 28 December 2007, applicant filed the present third renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3) and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is

an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Masami Yakura cannot be found. However, the petition does not sufficiently demonstrate that a diligent effort was made to locate Yakura. Petitioner has supplied evidence (see affidavit of Kazuo Wakabayashi and copies of letters) of attempts to reach Yakura by a single method, i.e. postal mail. Although the present renewed petition contains an affidavit which states that "considerable efforts" were made to reach Yakura (see 03 December 2007 affidavit of Kazuo Wakabayashi), no details of such considerable efforts have been provided. For example, petitioner has not established that petitioner tried to reach Yakura by other methods, e.g. by telephone, by electronic mail, by searching public directories, and by contacting Yakura's current employer. Thus, it would not be reasonable to conclude at the present time that Yakura cannot be located after diligent effort. Certain statements in the 03 December 2007 affidavit of Kazuo Wakabayashi suggest that Yakura may be refusing to sign. However, such a refusal has not been alleged, and the required showing (as detailed above) to support the assertion of a refusal to sign has not been made.

CONCLUSION

For the reasons above, the third renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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